

REMARKS

Applicant submits this response to the Office Action mailed September 28, 2010. Claims 1-4 and 6-30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2002/0010651 to Cohn. Applicant respectfully traverses this rejection.

Applicant herein amends independent Claim 11 to include the recitation of dependent Claim 15 and amends independent Claim 21 to include the recitation of dependent Claim 25. This brings claims 11 and 15 into alignment with previously amended Claim 1.

Previously Submitted Declarations under Rule 1.131 Should be Considered

Applicant respectfully submits that the presently claimed invention was reduced to practice prior to July 18, 2000. The claims of the present application were previously rejected as being anticipated by Cohn in an Office Action mailed November 26, 2004. In response, Applicant submitted (on March 28, 2005) Declarations under Rule 1.131 providing documentation as to the reduction to practice of the invention predating Cohn. Therefore, Cohn does not qualify as prior art under 35 U.S.C. § 102(e). As such, the rejection is improper and should be withdrawn.

The previously submitted Declarations under Rule 1.131 were not substantively addressed when they were originally filed, as the previous rejection of anticipation by Cohn was mooted in light of new grounds of rejection in an Office Action mailed June 28, 2005. Applicant respectfully requests that the previously submitted Declarations under Rule 1.131 be substantively addressed.

Cohn Does Not Disclose All Elements of the Claimed Invention

Even if Cohn were properly qualified as prior art under 35 U.S.C. § 102(e), Applicant respectfully asserts that Cohn does not disclose, teach, or suggest all of the elements of the independent claims of the present application. Independent Claims 1, 11 (as amended) and 21 (as amended) each recite determining whether a request to add a new category is received if it is determined that the service description should not be registered in the category.

The Office Action asserts that Cohn discloses determining whether a request to add a new category is received if it is determined that the service description should not be registered

in the category at paragraphs 0060-0066 and Figures 3a and 17a-b. Applicant respectfully disagrees with this assertion.

The cited sections of Cohn discuss categories generally. More specifically, the cited sections discuss the process of having a user categorize a company's profile by selecting appropriate categories and sub-categories from a local taxonomy (see, e.g., paragraph 0062). Importantly, Cohn states that "the company must be categorized using the list of categories associated with that PLI, that is, categories in the PartnerCategory table" (paragraph 0064). That is, Cohn limits the category choices to those in a predefined table, and does not seem to contemplate adding new categories. In fact, Applicant is unable to find any discussion in Cohn of adding a new category at all, and certainly not in response to a determination of whether a request to add a new category is received that is in turn dependent on a determination that a service description should not be registered in a category.

As Cohn does not disclose determining whether a request to add a new category is received if it is determined that the service description should not be registered in the category, as recited in independent Claims 1, 11, and 21, independent Claims 1, 11, and 21 are patentably distinct from Cohn. Since Claims 2-10 depend from Claim 1, Claims 12-20 depend from Claim 11, and Claims 22-30 depend from Claim 21, the dependent claims are also patentably distinct for at least the reasons described above.

CONCLUSION

Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite allowance of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 09-0461.

Respectfully submitted,



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